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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,355	05/01/2001	Tetsuo Nakamura	Q64193	2615

7590 06/02/2003

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[REDACTED] EXAMINER

CHEA, THORL

ART UNIT	PAPER NUMBER
	1752

DATE MAILED: 06/02/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

In

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/845,355	NAKAMURA ET AL.
	Examiner	Art Unit
	Thorl Chea	1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 13 May 2003.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 11-22 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 11-22 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

- 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 11-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Miyamoto et al (Miyamoto) and Hioki et al (Hioki).

Miyamoto discloses silver halide color photographic material containing silver halide emulsion containing dyes within the scope of the claimed invention. Note especially samples in Table 5, in columns 51-52; silver halide tabular grains in column 39, Table 2, in column 39, spectrally sensitizing dye of formula (I) in column 2 and the exemplified compounds in columns 5-12 wherein the dyes having a “ $-SO_3^-$ ” containing substituent and the other substituents are not the “ $-SO_3^-$ ” containing substituent, and these substituents have structure within the scope of the claimed invention. In the abstract, it is disclosed “the silver emulsion is subjected to spectral sensitization with at least one type of a methine compound represented by formula (I). In column 3 lines 10-15, Miyamoto prefers a substituent containing a sulfo group as R2. The most of exemplified compounds in Miyamoto are compounds containing a substituent having “ $-SO_3^-$ ” containing substituent and the other substituents containing a dissociable group other than “ $-SO_3^-$ ” containing substituent. In the formula (I) in column 2, it is disclosed that

"(X<sub>1</sub>)<sub>k</sub>" represents anion and k represents a number required to adjust the charge in the molecule to 0.

Hioki in column 5, lines 49-51, discloses that a sulfo group is described as "-SO<sub>3</sub><sup>-</sup>", but it can be described as "SO<sub>3</sub>H" when hydrogen ion is presented as a counter ion. The use of counter ions to balance the charge is disclosed in column 2, lines 30-35.

The difference between the claimed invention and that of Miyamoto is the "H" associated with the sulfo group. Miyamoto is silent with respect to the use of hydrogen atom to balance the charge of the dye molecule, but Hioki discloses that "H" can be used to balance the charge of dye molecule containing sulfo group. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use positively charged hydrogen to adjust the charge in the molecule of the dye taught in Miyamoto, and thereby provide an invention as claimed. Moreover, it would have been obvious to use one or more dye within the scope taught in Miyamoto to obtain the present claimed invention. "It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition to be used for the same purpose. *In re Kerkhoven*, 205 USPQ 1069, 1072 (CCPA 1980)."

#### ***Response to Arguments***

3. Applicant's arguments filed May 13, 2003 have been fully considered but they are not persuasive. It is the Examiner's position that it is *prima facie* obvious to combine two or more spectrally sensitizing dye each of which is taught by the prior art to be useful for the same purpose of spectrally sensitizing silver halide emulsion. It has been

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also common in the art to use more than one spectrally sensitizing dye to provide silver halide emulsion with supersensitizing effect.

It is also the Examiner's position that the Declaration under 37 CFR 1.132 fails to overcome the established *prima facie* case of obviousness rejection. First, the applicants fail to compare the claimed material to the closest prior art of record, namely Miyamoto et al. The statement in the argument with respect "the structures and amounts of the compounds used as slightly different, the differences are due to the progress technique and exert no influence on the relative comparison of the photographic property intended to be compared in the experiment" is based on the Counsel's assertion. Counsel's arguments cannot take the place of evidence. *In re Greenfield*, 571 F. 2d 1185, 197 USPQ 227 (CCPA 1978). The samples may contain same selenium compound, but contain no gold compound, and the type of silver halide may affect the speed of silver halide emulsion. Second, the Declaration is not commensurate with the scope of the claimed invention. "The data is not reasonably commensurate in scope with the claims, which, as drafted, are broad in scope and cover mixtures of numerous untested compounds. *Lindner*, 457 F. 2d at 508, 173 USPQ at 358." In this case the dye of formula (I) is so broad, where as the in the Declaration show only the combination of methine dye useful in the spectral sensitization of silver halide emulsion. Note to the definition of Dye, which is a dye moiety that encompasses dye other than a methine dye. The silver halide color photographic material claimed in the present claimed invention encompasses the silver halide color photographic material containing red-sensitive emulsion layer, green sensitive layer and blue

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sensitive layer, while the results shown in the Declaration are related to the results of the red sensitivity and cyan residual color, and blue-sensitivity and yellow residual color. The results in the green-sensitive emulsion layer has not shown. The Declaration shows only the use of the preferred silver halide tabular grains, while the scope of the claimed encompasses any type of silver halide grains in the samples taught in the applied prior art of record. Third, improvement shown in the Declaration is limited cyan residual color and sensitivity. The yellow residual color of sample 307 (comparative) in Table 4 is found to be less than that of the inventive sample 302. Accordingly, the invention as claimed is still *prima facie* obvious over the applied prior art of record.

### ***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9301 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

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tchea *TH*  
May 30, 2003



Thorl Chea  
Primary Examiner  
Art Unit 1752